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Attorneys for Plaintiffs  
BMW OF NORTH AMERICA, LLC and  
BAYERISCHE MOTOREN WERKE AG

**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
WESTERN DIVISION**

BMW OF NORTH AMERICA, LLC, a Delaware Limited Liability Company; and BAYERISCHE MOTOREN WERKE AG, a German Corporation,

## Plaintiffs,

V.

NEWEGG, INC., a Delaware Corporation; NUTREND AUTOMOTIVE, INC., a Delaware Corporation; OXK, LLC, a New York Limited Liability Company d/b/a GO BADGES; and DOES 1-10, inclusive.

### Defendants.

Case No.: 2:17-cv-05011

## **COMPLAINT FOR DAMAGES AND DECLARATORY RELIEF:**

- (1) **FEDERAL TRADEMARK INFRINGEMENT** [15 U.S.C. § 1114/Lanham Act §32(a)];
  - (2) **FALSE DESIGNATION OF ORIGIN/UNFAIR COMPETITION** [15 U.S.C. §1125(a)/Lanham Act §43(a)];
  - (3) **TRADEMARK DILUTION** [15 U.S.C. §1125(c)]; and
  - (4) **UNFAIR BUSINESS PRACTICES** [*CALIFORNIA BUSINESS & PROFESSIONS CODE* §17200]

**[DEMAND FOR JURY TRIAL]**

COMES NOW, Plaintiffs BMW OF NORTH AMERICA, LLC (“BMW NA”), and BAYERISCHE MOTOREN WERKE AG (“BMW AG”) (collectively “Plaintiffs”), to hereby file their Complaint for Damages and Declaratory Relief (“Complaint”) against Defendants NEWEGG, INC., NUTREND AUTOMOTIVE, INC., OXK, LLC d/b/a GO BADGES, and DOES 1-10, inclusive (collectively “Defendants”).

## PARTIES

8       1. Plaintiff BMW NA is now, and was at the time of the filing of this  
9 Complaint and at all intervening times, a Delaware limited liability company  
10 having its principal place of business in Woodcliff Lake, New Jersey. BMW NA's  
11 Technology Office, Western Region Office, Group Representative Office,  
12 Engineering and Emission Test Center, and Training Center are all located in  
13 California. Additionally, one of BMW NA's four Vehicle Distribution Centers and  
14 two of its six Parts Distribution Centers are located in California. BMW NA also  
15 has more than fifty (50) dealerships throughout the state of California. BMW NA  
16 is a wholly owned subsidiary of BMW (US) Holding Corporation, a Delaware  
17 corporation. BMW (US) Holding Corporation is an indirectly wholly-owned  
18 subsidiary of BMW AG.

19       2. Plaintiff BMW AG is now, and was at the time of the filing of this  
20 Complaint and at all intervening times, a German corporation organized under the  
21 laws of the Federal Republic of Germany with its principal place of business  
22 located in Munich, Germany.

23       3. Plaintiffs are informed and believe that Defendant NEWEGG, INC.  
24 (hereinafter “NEWEGG”) is now, and was at the time of the filing of this  
25 Complaint, and at all intervening times, an active Delaware corporation with its  
26 principal place of business located in City of Industry, California.

27       4. Plaintiffs are informed and believe that Defendant NUTREND  
28 AUTOMOTIVE, INC., (hereinafter “NUTREND”) is now, and was at the time of

1 the filing of this Complaint, and at all intervening times, an active Delaware  
2 corporation with its principal place of business located in City of Industry,  
3 California.

4       5. Plaintiffs are informed and believe that Defendant OXK, LLC,  
5 (hereinafter “OXK”) is now, and was at the time of the filing of this Complaint,  
6 and at all intervening times, an active New York limited liability company doing  
7 business as GO BADGES with its principal place of business located in Camillus,  
8 New York.

9       6. The true names and capacities, whether individual, corporate,  
10 associate or otherwise, of Defendants herein named as Does 1-10, inclusive, are  
11 unknown to Plaintiffs. Plaintiffs therefore sue said Defendants by such fictitious  
12 names. When the true names and capacities of said Defendants have been  
13 ascertained, Plaintiffs will amend this pleading accordingly.

14       7. Plaintiffs further allege that Defendants NEWEGG, NUTREND,  
15 OXK, and DOES 1-10, inclusive, sued herein by fictitious names, are jointly,  
16 severally and concurrently liable and responsible with one another upon the causes  
17 of action hereinafter set forth.

18       8. Plaintiffs are informed and believe and thereon allege that at all times  
19 mentioned herein Defendants NEWEGG, NUTREND, OXK, and DOES 1-10,  
20 inclusive, and each of them, were the agents, servants and employees of every  
21 other Defendant and the acts of each Defendant, as alleged herein, were performed  
22 within the course and scope of that agency, service or employment.

## **JURISDICTION / VENUE**

24       9. This Court has jurisdiction over the subject matter jurisdiction  
25 (violation of the Lanham Act) pursuant to 15 U.S.C. §1121 and/or 28 U.S.C. §§  
26 1331 and/or 1338(a).

27       10. This Court has personal jurisdiction over Defendants as Defendants  
28 conduct business within this jurisdiction and have committed the tortious activities

1 of trademark and patent infringement and unfair competition in this district.  
2 Defendants have sufficient minimum contacts with this district such that the  
3 exercise of jurisdiction over Defendants by this Court does not offend traditional  
4 notions of fair play and substantial justice. Among other things, Defendants have  
5 advertised, offered to sell, sold, and distributed products that infringe the  
6 trademarks and design patents of Plaintiffs to consumers within this judicial district  
7 for Defendants' own commercial gain and have exploited California's extensive  
8 marketplace, wherein Plaintiffs maintain substantial business contacts and financial  
9 interests. Specifically, Defendants have offered to sell and actually sold  
10 counterfeit products through the California-based website located at Newegg.com,  
11 the California-based eBay, Inc. platform, and using the California-based PayPal,  
12 Inc., to transact payment, while knowing or having reason to know that consumers  
13 throughout the United States, including within this judicial district, would purchase  
14 said counterfeit goods from Defendants, believing that they were authentic goods  
15 manufactured and distributed by Plaintiffs or their authorized manufacturers.  
16 Plaintiffs have felt a substantial part of the harm from Defendants' counterfeiting  
17 activities in the state of California, as a substantial portion of their offices and  
18 facilities are located in California.

19       11. Additionally, supplemental jurisdiction exists over Defendants  
20 because, on information and belief, Defendants conduct business in California and  
21 in this judicial district, have purposefully directed action to California and this  
22 district, or have otherwise availed themselves of the privileges and protections of  
23 the laws of the State of California, such that this Court's assertion of jurisdiction  
24 over Defendants does not offend traditional notions of fair play and due process.

25       12. Venue is proper in this district, *inter alia*, pursuant to 28 U.S.C.  
26 §1391(b) because, on information and belief, a substantial part of the events or  
27 omissions giving rise to these claims occurred in this judicial district, and has  
28 caused damage to Plaintiffs in this district. The counterfeit products featuring

1 Plaintiffs' Trademarks were advertised on a California-based Internet platform,  
2 paid through a California-based payment processor, purchased by California  
3 consumers, and Defendants purposefully shipped the counterfeit products to  
4 California. Defendants' actions within this district directly interfere with and  
5 damage Plaintiffs' commercial business and harms Plaintiffs' goodwill within this  
6 Venue.

7 **GENERAL ALLEGATIONS**

8 **Plaintiffs and their Well-Known BMW® Brand and Products**

9 13. Plaintiffs are in the business of designing, manufacturing, and/or  
10 distributing motor vehicles, wheels, motor vehicle parts and accessories, and a  
11 variety of other products which feature various trademarks, including but not  
12 limited to the BMW®, M®, MINI® and MINI COOPER® marks. Plaintiffs'  
13 BMW®, M®, MINI® and MINI COOPER®-branded products and marks have  
14 achieved great success since their introduction, some as early as 1955, 1987, and  
15 2008, respectively.

16 14. Plaintiffs' motor vehicles and related products have earned a  
17 reputation for innovation, quality and performance. Plaintiffs have spent  
18 substantial time, money and effort in developing consumer recognition and  
19 awareness of their BMW®, M®, MINI® and MINI COOPER®-branded products  
20 and marks. Plaintiffs have spent an enormous amount of money on print and  
21 Internet advertising in order to inform consumers of the benefits of Plaintiffs'  
22 products and services.

23 15. Through the extensive use of Plaintiffs' marks, Plaintiffs have built up  
24 and developed significant goodwill in their entire product line. A wide array of  
25 newspapers, magazines and television networks have included advertising of  
26 Plaintiffs' products, which are immediately identified by Plaintiffs' BMW®, M®,  
27 MINI®, and MINI COOPER® marks.

28 / / /

1       16. As a result of Plaintiffs' efforts, the quality of Plaintiffs' products, the  
2 high degree of promotion and the quality and popularity of the BMW® motor  
3 vehicles, the BMW®, M®, MINI®, and MINI COOPER® marks have been  
4 prominently placed in the minds of the public. Consumers, purchasers and the  
5 members of the public have become familiar with Plaintiffs' intellectual property  
6 and products, and have come to recognize the BMW®, M®, MINI® and MINI  
7 COOPER® marks and products and associate them exclusively with Plaintiffs.  
8 Plaintiffs have acquired a valuable reputation and goodwill among the public as a  
9 result of such association. Indeed, the BMW®, M®, MINI® and MINI  
10 COOPER® marks are famous in the United States and around the world.

## **Plaintiffs' Trademarks**

12        17. While Plaintiffs have gained significant common law trademark and  
13 other rights in their BMW®, M®, MINI® and MINI COOPER® products and  
14 services through their use, advertising and promotion, Plaintiffs have also  
15 protected their valuable rights by filing for and obtaining numerous federal  
16 trademark registrations. This includes registrations for the following non-  
17 exhaustive list of Plaintiff's registered trademarks:

18 i. **BMW**: United States Patent and Trademark Office (“USPTO”) Reg.  
19 No.: 0,611,710, registered September 6, 1955;

**BMW**

ii. USPTO Reg. No.: 0.613.465, registered October 4, 1955;



1           iii. USPTO Reg. No.: 1,450,212, registered August 4, 1987;



10          iv. USPTO Reg. No.: 2,816,178, registered February 24, 2004;

11           **BMW**

12

13          v. USPTO Reg. No.: 4,293,991, registered February 26, 2013;



17          vi. **M**: USPTO Reg. No.: 1,438,545, registered August 5, 1987;



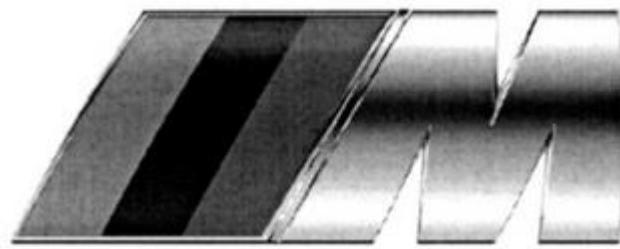
21          vii. USPTO Reg. No.: 3,526,899, registered November 4, 2008;



viii. USPTO Reg. No.: 3,767,662, registered March 30, 2010;



ix. USPTO Reg. No.: 3,767,663, registered March 30, 2010;



x. MINI: USPTO Reg. No.: 2,746,570, registered August 5, 2003;

MINI

xi. USPTO Reg. No.: 2,812,820, registered February 10, 2004;



xii. USPTO Reg. No.: 3,462,517, registered July 8, 2008;



xiii. USPTO Reg. No.: 3,507,903, registered September 30, 2008;

**MINI**

xiv. USPTO Reg. No.: 3,515,455, registered October 14, 2008;

MINI

xv. **MINI COOPER**: USPTO Reg. No.: 2,376,477, registered August 15, 2000; and

**MINI COOPER**

xvi. USPTO Reg. No.: 3,969,191, registered October 13, 2009  
(collectively, hereinafter “BMW® Trademarks”).

# MINI COOPER

18. Plaintiffs have never authorized or consented to Defendants' use of the BMW® Trademarks, or any confusingly similar marks by Defendants. Also, Plaintiffs have never authorized Defendants to copy, manufacture, import, market, sell, or distribute any BMW®, M®, MINI® and MINI COOPER® products.

## **Defendants' Wrongful and Infringing Conduct**

19. Particularly in light of the success of Plaintiffs and Plaintiffs' products, as well as the outstanding reputation they have gained, Plaintiffs and their products have become targets for unscrupulous individuals and entities who wish to take a "free ride" on their goodwill, reputation and fame. Plaintiffs have spent considerable effort and resources to build up in their products and marks.

1        20. Defendants use, amongst other things, the Internet website known as  
2 Amazon.com to advertise for sale, sell and distribute products, including  
3 counterfeit hard goods using and bearing BMW® Trademarks to consumers.

4        21. Items listed for sale on Amazon.com are assigned an Amazon  
5 Standard Identification Number (“ASIN”) by the Amazon seller portal. This  
6 number is a unique 10-character alphanumeric identification code that is assigned  
7 to a product when the product is first listed for sale on Amazon.com, often by the  
8 manufacturer of the product.

9        22. An Amazon.com listing contains a variety of information including  
10 the ASIN, Brand, Model, Manufacturer Part Number, Origin, Customer Reviews,  
11 Best Seller Rank, Product Weight, Shipping Weight, and Date First Available.  
12 The listing usually includes multiple photographs of the item, price, packaging,  
13 installation details, product details, shipping details, availability, and a hyperlink to  
14 a companion page providing detailed information regarding Buying Options,  
15 including the Seller Information of those Amazon sellers currently selling that  
16 product, their respective prices and shipping options.

17        23. Beginning on a date that is currently unknown to Plaintiffs and  
18 continuing to the present, Defendants have, without the consent of Plaintiffs,  
19 offered to sell and sold within the United States (including within this judicial  
20 district) goods that were neither made by Plaintiffs nor by a manufacturer  
21 authorized by Plaintiffs (such goods are hereafter referred to as “Counterfeit  
22 Goods”) using reproductions, counterfeits, copies and/or colorable imitations of  
23 one or more of the BMW® Trademarks.

24        24. On information and belief, Defendants imported said Counterfeit  
25 Goods into the United States, or encouraged others to import Counterfeit Goods  
26 into the United States, for the purpose of reselling the products.

27        25. On or about March 27, 2017, Plaintiffs made a test purchase of two  
28 sets of ASIN B00U24MEQC, described as “GoBadges EP16 MINI Cooper LED

1 Door Projection Courtesy Puddle Light – MINI,” for \$25.99 per pair, for a total  
2 purchase price of \$51.98, from Amazon seller “GoBadges,” which featured  
3 BMW® Trademarks, a product manufactured and distributed by Defendant OXK.

4 26. Electronic payment of \$51.98 for Amazon.com order number 002-  
5 6144530-1166639 was sent to Amazon seller “GoBadges.”

6 27. Also on or about that same date, March 27, 2017, Plaintiffs made a  
7 test purchase of one set of ASIN B00U24MEQC, described as “GoBadges EP16  
8 MINI Cooper LED Door Projection Courtesy Puddle Light – MINI,” for \$27.06  
9 per pair, from Amazon seller “Amazon.com LLC,” which featured BMW®  
10 Trademarks, a product manufactured and distributed by Defendant OXK.

11 28. Electronic payment of \$29.43 for Amazon.com order number 002-  
12 2954505-8677865 sent to Amazon seller “Amazon.com LLC.”

13 29. On or about March 28, 2017, Plaintiffs made a test purchase of two  
14 sets of ASIN B00U24MER6, described as “GoBadges EP19 MINI Cooper LED  
15 Door Projection Courtesy Puddle Light – UNIONJACK,” for \$34.99 per pair, for a  
16 total of \$76.10, from Amazon seller “Amazon.com LLC,” which featured BMW®  
17 Trademarks, a product manufactured and distributed by Defendant OXK.

18 30. Electronic payment of \$76.10 for Amazon.com order number 114-  
19 6384704-6599466 was sent to Amazon seller “Amazon.com LLC.”

20 31. On or about that same date, March 28, 2017, Plaintiffs made a test  
21 purchase of two sets of ASIN B00U24MEQC, described as “GoBadges EP16  
22 MINI Cooper LED Door Projection Courtesy Puddle Light – MINI,” for \$37.55  
23 per pair, for a total of \$80.54, from Amazon seller “Autocare Depot,” which  
24 featured BMW® Trademarks, a product manufactured and distributed by  
25 Defendant OXK.

26 32. Electronic payment of \$80.54 for Amazon.com order number 114-  
27 6454835-8054616 was sent to Amazon seller “Autocare Depot.”

28 / / /

1       33. Through Amazon.com, using ASIN B00U24MEQC and ASIN  
 2 B00U24MER6, Defendants regularly and systematically advertised, marketed,  
 3 distributed and sold a presently unknown quantity of counterfeit car door projector  
 4 lights with accessories bearing the BMW® Trademarks.

5       34. On or about April 4, 2017, in the course of Plaintiffs' ongoing  
 6 investigation of counterfeit sales of BMW®, M®, MINI® and MINI COOPER®-  
 7 branded products, Plaintiffs made a test purchase of one unit of ASIN  
 8 B00YRCWUEQ, described as "GoBadges Men's Mini Cooper Short Sleeve  
 9 Premium T-Shirt (Black, Medium-Mini)," for \$19.99, from Amazon seller  
 10 "Amazon.com LLC," which featured BMW® Trademarks, a product manufactured  
 11 and distributed by Defendant OXK.

12      35. Also on or about April 4, 2017, Plaintiffs made a test purchase of one  
 13 unit of ASIN B00YRCWUG4, described as "GoBadges Men's Mini Cooper Short  
 14 Sleeve Premium T-Shirt (Black, X-Large-Mini)," for \$19.99, from Amazon seller  
 15 "Amazon.com LLC," which featured BMW® Trademarks, a product manufactured  
 16 and distributed by Defendant OXK.

17      36. Additionally, on or about April 4, 2017, Plaintiffs also made a test  
 18 purchase of one unit of ASIN B00YRCX39W, described as "GoBadges Women's  
 19 Mini Cooper Short Sleeve Premium T-Shirt (White, Medium-Mini)," for \$19.99,  
 20 from Amazon seller "Amazon.com LLC," which featured BMW® Trademarks, a  
 21 product manufactured and distributed by Defendant OXK.

22      37. On or about April 4, 2017, Plaintiffs made a test purchase of one unit  
 23 of ASIN B06XX71D2Q, described as "MINI COOPER BLACK -Valve Stem  
 24 Caps with KeyChain Wrench / UNIVERSAL Fit / 4 pcs Set," for \$9.99, from  
 25 Amazon seller "Amazon.com LLC," which featured BMW® Trademarks, a  
 26 product manufactured and distributed by Defendant OXK.

27      38. On or about April 4, 2017, Plaintiffs made a test purchase of one unit  
 28 of ASIN B00YRCX2XO, described as "GoBadges Men's Mini Cooper Short

1 Sleeve Premium T-Shirt (White, Medium-Mini)," for \$19.99, from Amazon seller  
2 "Amazon.com LLC," which featured BMW® Trademarks, a product manufactured  
3 and distributed by Defendant OXK.

4       39. Further, on or about April 4, 2017, Plaintiffs made a test purchase of  
5 one unit of ASIN B00YRCWUX2, described as "GoBadges Men's Mini Cooper  
6 Short Sleeve Premium T-Shirt (Black, Large-Mini)," for \$18.02, from Amazon  
7 seller "Amazon.com LLC," which featured BMW® Trademarks, a product manufactured  
8 and distributed by Defendant OXK.

9       40. On or about April 4, 2017, Plaintiffs made a test purchase of one unit  
10 of ASIN B00YRCWYMO, described as "GoBadges Men's Mini Cooper Short  
11 Sleeve Premium T-Shirt (White, X-Large-Mini)," for \$18.02, from Amazon seller  
12 "Amazon.com LLC," which featured BMW® Trademarks, a product manufactured  
13 and distributed by Defendant OXK.

14       41. Moreover, on or about April 4, 2017, Plaintiffs made a test purchase  
15 of one unit of ASIN B00BHD66Y8, described as "GoBadges WA03 Union Jack  
16 Wheel Cap for MINI Cooper," for \$32.99, from Amazon seller "Amazon.com  
17 LLC," which featured BMW® Trademarks, a product manufactured and  
18 distributed by Defendant OXK.

19       42. On or about April 4, 2017, Plaintiffs also made a test purchase of one unit  
20 of ASIN B00YRCX324, described as "GoBadges Women's Mini Cooper  
21 Short Sleeve Premium T-Shirt (Black, X-Large-Mini)," for \$19.99, from Amazon  
22 seller "Amazon.com LLC," which featured BMW® Trademarks, a product manufactured  
23 and distributed by Defendant OXK.

24       43. On or about April 4, 2017, Plaintiffs made a test purchase of one unit  
25 of ASIN B00BHD637S, described as "GoBadges WA02 Black Jack Wheel Cap  
26 for MINI Cooper," for \$32.99, from Amazon seller "Amazon.com LLC," which  
27 featured BMW® Trademarks, a product manufactured and distributed by  
28 Defendant OXK.

1       44. Electronic payment of \$229.65 for Amazon.com order number 112-  
2 4376960-67786745 was sent to Amazon seller “Amazon.com LLC.”

3       45. On or about April 7, 2017, in the course of Plaintiffs’ ongoing  
4 investigation of counterfeit sales of BMW®, M®, MINI® and MINI COOPER®-  
5 branded products, Plaintiffs made a test purchase from eBay seller “autocaredepot”  
6 of one “GoBadges EP16 MINI Cooper LED Door Projection Courtesy Puddle  
7 Lights” for a cost of \$42.83, including tax, charged to the PayPal electronic  
8 payment account of Plaintiffs’ investigator. The PayPal receipt reflects that  
9 payment was sent to Defendant NUTREND.

10      46. On or about April 11, 2017, in the course of Plaintiffs’ ongoing  
11 investigation of counterfeit sales of BMW®, M®, MINI® and MINI COOPER®-  
12 branded products, using the e-commerce website located at www.GoBadges.com,  
13 owned and maintained by Defendant OXK, LLC, Plaintiffs made a test purchase of  
14 one set of “GoBadges MINI COOPER LED DOOR PROJECTION COURTESY  
15 PUDDLE LIGHTS,” for \$29.99, which featured BMW® Trademarks, a product  
16 manufactured and distributed by Defendant OXK.

17      47. Also on or about April 11, 2017, using the e-commerce website  
18 located at www.GoBadges.com, owned and maintained by Defendant OXK, LLC.,  
19 Plaintiffs made a test purchase of one set of “GoBadges EP16-R-MINI  
20 REPLACEMENT LENSES for LED DOOR PUDDLE LIGHTS,” for \$9.99,  
21 which featured BMW® Trademarks, a product manufactured and distributed by  
22 Defendant OXK.

23      48. Further, on or about April 11, 2017, using the e-commerce website  
24 located at www.GoBadges.com, owned and maintained by Defendant OXK, LLC.,  
25 Plaintiffs made a test purchase of one set of “GoBadges MEN’S MINI COOPER  
26 SHORT SLEEVE PREMIUM T-SHIRT – MINI (BLACK), Product Code  
27 AP001,” for \$19.99, which featured BMW® Trademarks, a product manufactured  
28 and distributed by Defendant OXK.

1       49. All of the items purchased on April 11, 2017, were charged to the  
2 PayPal electronic payment account of Plaintiffs. The PayPal receipt reflects that  
3 payment was sent to “GoBadges.”

4       50. On or about April 14, 2017, in the course of Plaintiffs’ ongoing  
5 investigation of counterfeit sales of BMW®, M®, MINI® and MINI COOPER®-  
6 branded products, using the e-commerce website located at www.newegg.com,  
7 Plaintiffs made a test purchase of one “Race Sport LED Illumination Badge  
8 (BMW-Red) BMW-LED-RED, item #9SIA08C2WY3110” for \$49.47, including  
9 tax, charged to the PayPal electronic payment account of Plaintiffs’ investigator.  
10 The PayPal record reflects that payment was sent to Newegg.com, the domain  
11 name owned and operated by Defendant NEWEGG.

12      51. On or about April 14, 2017, in the course of Plaintiffs’ ongoing  
13 investigation of counterfeit sales of BMW® M®, MINI® and MINI COOPER®-  
14 branded products, Plaintiffs made a test purchase from eBay seller “autocaredepot”  
15 of one “Race Sport LED Illumination Badge (BMW-Blue) BMW-LED-BLUE,”  
16 for a cost of \$49.58, including tax, charged to the PayPal electronic payment  
17 account of Plaintiffs’ investigator. The PayPal receipt reflects that payment was  
18 sent to Defendant NUTREND.

19      52. The lighting fixtures, badges, valve stem caps, clothing, and other  
20 items described in detail above, which were obtained from Defendants, were  
21 inspected by Plaintiffs to determine authenticity. Plaintiffs’ inspection of the  
22 purchased items confirmed that the items sold by Defendants are in fact counterfeit  
23 products infringing upon the BMW® Trademarks.

24      53. Based on the known conduct of Defendants’ marketing, advertising,  
25 offering for sale, and sale of a wide variety of counterfeit products infringing on  
26 the BMW® Trademarks, Defendants are likely also offering for sale and selling  
27 other relevant and related infringing products that will be disclosed during the  
28 discovery process.

1       54. By these sales and on information and belief, Defendants violated and  
2 continue to violate Plaintiffs' exclusive rights to the BMW® Trademarks and use  
3 images and marks that are confusingly similar to, identical to, and/or constitute  
4 counterfeit reproductions of the BMW® Trademarks to confuse consumers and aid  
5 in the promotion and sales of its unauthorized goods.

6       55. Defendants' conduct and use began long after Plaintiffs' adoption and  
7 use of their BMW® Trademarks, after Plaintiffs obtained the trademark  
8 registrations alleged above, and after the BMW® Trademarks became famous.  
9 Indeed, Defendants had knowledge of Plaintiffs' ownership of the marks, and of  
10 the fame in such marks, prior to the actions alleged herein, and adopted them in  
11 bad faith and with intent to tarnish, counterfeit and dilute Plaintiffs' marks and  
12 products as well as cause confusion to their customers. Neither Plaintiffs nor any  
13 authorized agents have consented to Defendants' use of BMW® Trademarks in the  
14 manner complained of herein.

15       56. Defendants' actions were committed willfully, in bad faith and with  
16 the intent to dilute Plaintiffs' marks, and to cause confusion and mistake, and to  
17 deceive the consuming public and the public at large as to the source, sponsorship  
18 and/or affiliation of Defendants, and/or Defendants' counterfeit and unauthorized  
19 goods. By their wrongful conduct, Defendants have traded upon and diminished  
20 Plaintiffs' goodwill.

21       57. In committing these acts, Defendants have, among other things,  
22 willfully and in bad faith committed the following acts, all of which have and will  
23 continue to cause irreparable harm to Plaintiffs: (i) infringed, tarnished, and diluted  
24 Plaintiffs' rights in the BMW® Trademarks; (ii) applied counterfeit marks; (iii)  
25 misled the public into believing there is an association or connection between  
26 Defendants and Plaintiffs and/or the products advertised and sold by Defendants  
27 and Plaintiffs; (iv) used false designations of origin on or in connection with its  
28 goods and services; (v) committed unfair competition; (vi) engaged in

1 counterfeiting; and (vii) unfairly profited from such activity. Unless enjoined,  
2 Defendants will continue to cause irreparable harm to Plaintiffs.

3 **FIRST CAUSE OF ACTION**

4 **(Infringement of Registered Trademarks against Defendants NEWEGG, INC.,  
5 NUTREND AUTOMOTIVE, INC., OXK, LLC d/b/a GO BADGES, and  
6 DOES 1 through 10, Inclusive)**

7 **[15 U.S.C. §1114/Lanham Act §32(a)]**

8 58. Plaintiffs hereby incorporate by reference each of the other allegations  
9 set forth elsewhere in this Complaint as though fully set forth in this cause of  
10 action.

11 59. Plaintiffs have continuously used the BMW® Trademarks in interstate  
12 commerce.

13 60. Plaintiffs, as the owners of all right, title and interest in and to the  
14 BMW® Trademarks, have standing to maintain an action for trademark  
15 infringement under the U.S. Trademark Statute, 15 U.S.C. §1114.

16 61. Defendants are and at the time of their actions complained of herein  
17 were actually aware that Plaintiffs are the registered trademark holders of the  
18 BMW® Trademarks.

19 62. Defendants did not and failed to obtain the consent or authorization of  
20 Plaintiffs as the registered owners of the BMW® Trademarks to deal in and  
21 commercially distribute, market and sell products bearing Plaintiffs' asserted  
22 marks into the stream of commerce.

23 63. Defendants intentionally and knowingly used in commerce the  
24 reproductions, counterfeits, copies, and/or colorable imitations of Plaintiffs'  
25 asserted marks in connection with the sale, offering for sale, distribution, or  
26 advertising of Defendants' goods by offering, advertising, promoting, retailing,  
27 selling, and distributing counterfeit BMW® products bearing the BMW®  
28 Trademarks.

1       64. Defendants reproduced, counterfeited, copied, and colorably imitated  
2 Plaintiffs' registered BMW® Trademarks and applied such reproductions,  
3 counterfeits, copies, or colorable imitations to emblems, labels, signs, prints,  
4 packages, wrappers, receptacles, websites and/or advertisements intended to be  
5 used in commerce upon or in connection with the sale, offering for sale,  
6 distribution, and/or advertising of goods. Defendants thereupon offered,  
7 advertised, promoted, retailed, sold, and distributed counterfeit BMW® products  
8 bearing the BMW® Trademarks.

9       65. Defendants' egregious and intentional use and sale of counterfeit  
10 items bearing Plaintiffs' BMW® Trademarks is likely to cause confusion, or to  
11 cause mistake, or to deceive, mislead, betray, and defraud consumers who believe  
12 that Defendants' items are authentic products manufactured by Plaintiffs.

13       66. Defendants' acts have been committed with knowledge of Plaintiffs'  
14 exclusive rights and goodwill in the marks, as well as with bad faith and the intent  
15 to cause confusion or to cause mistake and to deceive.

16       67. Plaintiffs have suffered and will continue to suffer substantial and  
17 irreparable injury, loss and damage to its rights in and to the BMW® Trademarks  
18 and the goodwill associated therewith, for which it has no adequate remedy at law;  
19 thus Plaintiffs request injunctive relief.

20       68. Defendants' continued and knowing use of Plaintiffs' asserted marks  
21 without Plaintiffs' consent or authorization constitutes intentional infringement of  
22 Plaintiffs' federally registered trademarks in violation of Section 32 of the *Lanham*  
23 *Act*, 15 U.S.C. §1114. Based on such conduct, Plaintiffs are entitled to injunctive  
24 relief as well as monetary damages, and other remedies provided by section 1116,  
25 1117, and 1118, including Defendants' profits, treble damages, reasonable  
26 attorneys' fees, costs, statutory damages and/or prejudgment interest.

27       ///

28       ///

## **SECOND CAUSE OF ACTION**

**(False Designation of Origin & Unfair Competition against Defendants  
NEWEGG, INC., NUTREND AUTOMOTIVE, INC., OXK, LLC d/b/a GO  
BADGES, and DOES 1 through 10, Inclusive)**

[15 U.S.C. §1125(a)/Lanham Act §43(a)]

69. Plaintiffs hereby incorporate by reference each of the other allegations set forth elsewhere in this Complaint as though fully set forth in this cause of action.

70. Plaintiffs, as the owners of all common law right, title, and interest in and to the BMW® Trademarks, have standing to maintain an action for false designation of origin and unfair competition under the Federal Trademark Statute, Lanham Act section 43(a) (15 U.S.C. §1125). Plaintiffs' asserted marks are fanciful, inherently distinctive and/or have otherwise acquired distinctiveness.

71. Defendants have without authorization, on or in connection with its goods and services, used in commerce marks that are confusingly similar to the asserted marks, and/or has made false designations of origin which are likely to cause confusion or cause mistake or to deceive as to the affiliation, connection or association of Defendants with Plaintiffs, and/or as to the origin, sponsorship or approval of Defendants' goods or services or commercial activities.

72. Defendants' conduct described above violates the Lanham Act, and Defendants have unfairly competed with and injured and, unless immediately restrained, will continue to injure Plaintiffs, causing damage to Plaintiffs in an amount to be determined at trial, and will cause irreparable injury to Plaintiffs' goodwill and reputation associated with the value of Plaintiffs' marks.

73. On information and belief, the conduct of Defendants has been knowing, deliberate, willful, intended to cause confusion, or to cause mistake or to deceive and in blatant disregard of Plaintiffs' rights.

111

1       74. Defendants knew, or by the exercise of reasonable care should have  
 2 known, that their adoption and commencement of use in commerce and continuing  
 3 use of marks that are confusingly similar to and constitute a counterfeit  
 4 reproduction of Plaintiffs' asserted marks would cause confusion, mistake, or  
 5 deception among purchasers, users and the public.

6       75. Defendants' egregious and intentional use and sale of fake, pirated  
 7 and counterfeit items bearing Plaintiffs' asserted marks unfairly competes with  
 8 Plaintiffs and is likely to cause confusion, mistake, or to deceive, mislead, betray,  
 9 and defraud consumers to believe that the substandard imitations are genuine  
 10 BMW® products.

11       76. Defendants' continuing and knowing use of the BMW® Trademarks  
 12 constitutes false designation of origin and unfair competition in violation of  
 13 Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a), causing Plaintiffs to suffer  
 14 substantial and irreparable injury for which it has no adequate remedy at law.

15       77. Defendants' wrongful conduct has permitted or will permit it to make  
 16 substantial sales and profits on the strength of Plaintiffs' marketing, advertising,  
 17 sales and consumer recognition. As a direct and proximate result of Defendants'  
 18 wrongful conduct, as alleged herein, Plaintiffs have been and will be deprived of  
 19 sales of its BMW® products in an amount as yet unknown but to be determined at  
 20 trial, and have been deprived and will be deprived of the value of their marks as  
 21 commercial assets in an amount as yet unknown but to be determined at trial.  
 22 Plaintiffs seek damages and an accounting of Defendants' profits, and requests that  
 23 the Court grant Plaintiffs three times that amount in the Court's discretion.

24       78. Based on Defendants' wrongful conduct, Plaintiffs are entitled to  
 25 injunctive relief as well as monetary damages, and other remedies as provided by  
 26 the Lanham Act, including Defendants' profits, treble damages, reasonable  
 27 attorneys' fees, costs and prejudgment interest.

28       / / /

### **THIRD CAUSE OF ACTION**

**(Trademark Dilution against Defendants NEWEGG, INC., NUTREND AUTOMOTIVE, INC., OXK, LLC d/b/a GO BADGES, and DOES 1 through 10, Inclusive)**

[15 U.S.C. §1125(c)]

79. Plaintiffs hereby incorporate by reference each of the other allegations set forth elsewhere in this Complaint as though fully set forth in this cause of action.

9       80. Plaintiffs' BMW® Trademarks are distinctive and famous within the  
0 meaning of the Lanham Act.

81. Upon information and belief, Defendants' unlawful actions began long after Plaintiffs' asserted marks became famous, and Defendants acted knowingly, deliberately and willfully with the intent to trade on Plaintiffs' reputation and to dilute Plaintiffs' asserted marks. Defendants' conduct is willful, wanton and egregious.

82. Defendants' intentional sale of fake, pirated and counterfeit items bearing Plaintiffs' asserted marks is likely to cause confusion, mistake, or to deceive, mislead, betray, and defraud consumers to believe that the substandard imitations are genuine BMW® products. The actions of Defendants complained of herein have diluted and will continue to dilute the BMW® Trademarks and other marks, and are likely to impair the distinctiveness, strength and value of Plaintiffs' marks, and injure the business reputation of Plaintiffs and their marks.

83. Defendants' acts have caused and will continue to cause Plaintiffs irreparable harm. Plaintiffs have no adequate remedy at law to compensate it fully for the damages that have been caused and which will continue to be caused by Defendants' unlawful acts, unless they are enjoined by this Court.

84. As the acts alleged herein constitute a willful violation of section 43(c) of the Lanham Act, 15 U.S.C. section 1125(c), Plaintiffs are entitled to

1 injunctive relief as well as monetary damages and other remedies provided by 15  
2 U.S.C. §§1116, 1117, 1118, and 1125(c), including Defendants' profits, actual and  
3 statutory damages, treble damages, reasonable attorney's fees, costs and  
4 prejudgment interest.

5 **FOURTH CAUSE OF ACTION**

6 **(Unlawful, Unfair, Fraudulent Business Practices against Defendants**  
7 **NEWEGG, INC., NUTREND AUTOMOTIVE, INC., OXK, LLC d/b/a GO**  
8 **BADGES, and DOES 1 through 10, Inclusive)**

9 [*California Business & Professions Code §17200 et seq.*]

10 85. Plaintiffs hereby incorporate by reference each of the other allegations  
11 set forth elsewhere in this Complaint as though fully set forth in this cause of  
12 action.

13 86. By marketing, advertising, promoting, selling and/or otherwise  
14 dealing in counterfeit BMW® products, Defendants have engaged in unfair  
15 competition including unlawful, unfair and fraudulent business practices in  
16 violation of the *California Business and Professions Code §17200 et seq.*

17 87. Defendants' marketing, advertising, promoting, selling and/or  
18 otherwise dealing in the counterfeit BMW® products is in violation and derogation  
19 of Plaintiffs' rights and is likely to cause confusion, mistake and deception among  
20 consumers and the public as to the source, origin, sponsorship, or quality of the  
21 goods of Defendant, thereby causing loss, damage and injury to Plaintiffs and to  
22 the purchasing public. Defendants' conduct was intended to cause such loss,  
23 damage and injury.

24 88. Defendants knew or by the exercise of reasonable care should have  
25 known that their marketing, advertising, promoting, selling and/or otherwise  
26 dealing in and their continuing marketing, advertising, promoting, selling and/or  
27 otherwise dealing in the counterfeit product would cause confusion mistake or  
28 deception among purchasers, users and the public.

89. By marketing, advertising, promoting, selling and/or otherwise dealing in and their continuing marketing, advertising, promoting, selling and/or otherwise dealing in counterfeit versions of Plaintiffs marks and products, Defendants intended to, did and will continue to induce customers to purchase its false and counterfeit products by trading off the extensive goodwill built up by Plaintiffs' in their marks.

90. Upon information and belief, the conduct of Defendants has been knowing, deliberate, willful, intended to cause confusion, or to cause mistake or to deceive, and in disregard of Plaintiffs' rights.

91. Defendants' wrongful conduct, as alleged above, has permitted and will permit them to make substantial sales and profits on the strength of Plaintiffs' nationwide marketing, advertising, sales and consumer recognition. As a direct and proximate result of Defendants' wrongful conduct, as alleged herein, Plaintiffs have been and will be deprived of substantial sales of their products in an amount as yet unknown but to be determined at trial, and have been and will be deprived of the value of their trademarks as commercial assets, in an amount as yet unknown but to be determined at trial. Plaintiffs seek restitution in this matter, including an order granting Defendants' profits stemming from its infringing activity, and their actual and/or compensatory damages.

92. Plaintiffs have no adequate remedy at law for Defendants' continuing violation of its rights set forth above. Plaintiffs seek injunctive relief.

93. Plaintiffs further request a court issue an order to “freeze” any assets or impose a constructive trust over all monies and assets in Defendants’ possession which rightfully belong to Plaintiffs.

## **PRAYER FOR RELIEF**

WHEREFORE, Plaintiffs BMW of North America, LLC and Bayerische Motoren Werke AG pray for judgment against Defendants Newegg, Inc., Nutrend Automotive, Inc., OXK, LLC d/b/a Go Badges, and Does 1 through 10, inclusive,

1 and each of them, as follows:

- 2 1. For an award of Defendants' profits and Plaintiffs' damages in an amount  
3 to be proven at trial for trademark infringement under 15 U.S.C.  
4 §1114(a);  
5 2. For an award of Defendants' profits and Plaintiffs' damages in an amount  
6 to be proven at trial for false designation of origin and unfair competition  
7 under 15 U.S.C. §1125(a);  
8 3. For \$2,000,000.00 per counterfeit mark per type of goods sold, offered  
9 for sale, or distributed under 15 U.S.C. §1117(c).  
10 4. For an award of Defendants' profits and Plaintiffs' damages in an amount  
11 to be proven at trial for trademark dilution under 15 U.S.C. §1125(c);  
12 5. In the alternative to actual damages and Defendants' profits for the  
13 infringement and counterfeiting of Plaintiffs' trademarks pursuant to the  
14 Lanham Act, for statutory damages pursuant to 15 U.S.C. §1117(c),  
15 which election Plaintiffs will make prior to the rendering of final  
16 judgment;  
17 6. For restitution in an amount to be proven at trial for unfair, fraudulent  
18 and illegal business practices under *Business and Professions Code*  
19 §17200;  
20 7. For temporary, preliminary and permanent injunctive relief from this  
21 Court prohibiting Defendants from engaging or continuing to engage in  
22 the unlawful, unfair, or fraudulent business acts or practices described  
23 herein, including the advertising and/or dealing in any counterfeit  
24 product; the unauthorized use of any mark, copyright or other intellectual  
25 property right of Plaintiffs; acts of trademark infringement or dilution;  
26 false designation of origin; unfair competition; and any other act in  
27 derogation of Plaintiffs' rights;

- 1       8. For an order from the Court requiring that Defendants provide complete
- 2           accountings and for equitable relief, including that Defendants disgorge
- 3           and return or pay their ill-gotten gains obtained from the illegal
- 4           transactions entered into and or pay restitution, including the amount of
- 5           monies that should have been paid if Defendants' complied with their
- 6           legal obligations, or as equity requires;
- 7       9. For an order from the Court that an asset freeze or constructive trust be
- 8           imposed over all monies and profits in Defendants' possession which
- 9           rightfully belong to Plaintiffs;
- 10      10. For destruction of the infringing articles in Defendants' possession under
- 11           15 U.S.C. §1118;
- 12      11. For treble damages suffered by Plaintiffs as a result of the willful and
- 13           intentional infringements and acts of counterfeiting engaged in by
- 14           Defendants, under 15 U.S.C. §1117(b);
- 15      12. For damages in an amount to be proven at trial for unjust enrichment;
- 16      13. For an award of exemplary or punitive damages in an amount to be
- 17           determined by the Court;
- 18      14. For Plaintiffs' reasonable attorney's fees;
- 19      15. For all costs of suit; and
- 20      16. For such other and further relief as the Court may deem just and
- 21           equitable.

22 DATED: July 7, 2017

JOHNSON & PHAM, LLP

23           By: /s/\_Marcus F. Chaney\_\_  
24           Christopher D. Johnson, Esq.  
25           Christopher Q. Pham, Esq.  
26           Marcus F. Chaney, Esq.  
27           Nicole Drey Huerter, Esq.  
28           Attorneys for Plaintiffs  
                 BMW OF NORTH AMERICA, LLC and  
                 BAYERISCHE MOTOREN WERKE AG

**DEMAND FOR JURY TRIAL**

Plaintiffs BMW of North America, LLC and Bayerische Motoren Werke AG respectfully demand a trial by jury in this action pursuant to Local Rule 38-1.

DATED: July 7, 2017

JOHNSON & PHAM, LLP

By: /s/ Marcus F. Chaney  
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Christopher Q. Pham, Esq.  
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BMW OF NORTH AMERICA, LLC and  
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